

REMARKS

In the Final Office Action, the Examiner objected to claims 268 and 269 for informalities. She rejected claims 201, 205-207, 209, 212, 214-217, 221-223, 225, 228, 230-234 and 268 under 35 U.S.C. § 102(e) as being anticipated by *Kahn et al.*, U.S. Patent No. 6,401,079 B1, ("*Kahn et al.*"). She also rejected claims 208, 210, 211, 213, 224, 226, 227 and 229 under 35 U.S.C. § 103(a) as being unpatentable over *Kahn et al.* in view of Official Notice. She further rejected claims 202-204 and 218-220 under 35 U.S.C. § 103(a) as being unpatentable over *Kahn et al.* in view of *Embrey*, U.S. Patent No. 6,311,170 B1, ("*Embrey*"). She also rejected claims 267 under 35 U.S.C. § 103(a) as being unpatentable over *Kahn et al.* in view of *Fulton et al.*, U.S. Patent No. 6,182,052 B1, ("*Fulton et al.*"). Finally, she rejected claims 201-234 on the ground of nonstatutory obvious-type double patenting as being unpatentable over claims 1-48 of U.S. Patent No. 5,946,669 ("the '669 Patent") and over claims 1-70 of U.S. Patent No. 6,119,107 ("the '107 Patent").

Claims 201-234 and 267-268 are currently pending. By this Amendment, Applicants have amended claims 201, 203, 204, 217, 219, 220, 233, 234, 267 and 268 to clarify aspects of the invention. Applicants have also cancelled claims 202 and 218 without disclaiming the subject matter therein. No new matter has been added by this Amendment.

I. Claim Objection

The Examiner objected to claims 268 and 269 for inadvertently claiming dependency of claim 1 when both claims should have claimed dependency of claim

201. (Final Office Action, p.3, ¶ 3.) Although the current application does not contain claim 269, claims 267 and 268 both claim dependency of claim 1. Thus, Applicants believe the Examiner meant to object to claims 267 and 268, and Applicants have amended claims 267 and 268 to claim dependency of claim 201. Therefore, Applicants respectfully request the Examiner withdraw the claim objections with respect to claims 267 and 268.

II. Claim Rejection Under 35 U.S.C. § 102(e)

To establish that *Kahn et al.* anticipates Applicants' claims under 35 U.S.C. § 102(e), the Examiner must show that *Kahn et al.* discloses each and every element of Applicants' claims, either expressly or inherently. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). Furthermore, the identical disclosure "must be shown in as complete detail as is contained in the... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Because *Kahn et al.* does not disclose each recitation of Applicants' amended claims, Applicants traverse the rejection.

Applicants have amended independent claim 201 to include recitations of dependent claim 202. *Kahn et al.* does not disclose "a method for processing payments over a network for a plurality of intermediaries, comprising . . . verifying the employee information using verification information received from an intermediary." In formulating rejections under 35 U.S.C. § 102(e), the Examiner explicitly excluded claim 202, further evidencing the lack of disclosure of *Kahn et al.* of recitations contained in claim 202, now incorporated in amended independent claim 201.

Similarly, Applicants have amended independent claim 217 to include recitations of dependent claim 218. Dependent claim 218 contains similar recitations as claim 202 and was also excluded from the Examiner's rejection under 35 U.S. C. § 102(e). Amended independent claim 217 contains similar recitations to amended independent claim 201. Recitations contain in claim 201 are also substantially contained in amended independent claims 233 and 234. Therefore, at least for the same reason stated above with respect to claim 201, Applicants submit that claims 217, 233 and 234 contain recitations that are not disclosed, expressly or inherently, in *Kahn et al.*

Dependent claims 205-207, 209, 212, 214-216, 221-223, 225, 228, 230-232 and 268 necessarily include the recitations of their respective independent claims, and, therefore, also contain recitations not disclosed by *Kahn et al.* Applicants therefore respectfully request that the Examiner withdraw the 35 U.S.C. § 102(e) rejection with respect to claims 201, 205-207, 209, 212, 214-217, 221-223, 225, 228, 230-234 and 268, as amended.

III. Claim Rejection Under 35 U.S.C. § 103(a)

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the references, taken alone or combined, must teach or suggest each and every element recited in the claims. M.P.E.P. § 2143 (8th ed. 2001, revised August 2007).

Furthermore, as the Deputy Commissioner for Patent Operations recently confirmed, "in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in

the art would have combined the prior art elements in the manner claimed.” May 3, 2007 U.S.P.T.O. Memorandum from Margaret A. Focarino.

1. *Kahn et al.* in view of Official Notice

Applicants have amended independent claim 201 to include recitations of dependent claim 202. As stated above, *Kahn et al.* fails to disclose “a method for processing payments over a network for a plurality of intermediaries, comprising . . . verifying the employee information using verification information received from an intermediary” as recited in amended independent claim 201 and substantially recited in amended independent claim 217. The Official Notice is taken with respect to a communication method using paper and a network that is an intranet, a wireless network, and a virtual private network. However, the Official Notice fails to remedy the deficiency of *Kahn et al.*

Dependent claims 208, 210, 211, 213, 224, 226, 227 and 229 necessarily include the recitations of their respective independent claims, and, therefore, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a) with respect to these claims. Applicants therefore respectfully request that the Examiner withdraw the 35 U.S.C. § 10(a) rejection with respect to claims 208, 210, 211, 213, 224, 226, 227 and 229, as amended.

2. *Kahn et al.* in view of *Embrey*

The Examiner raised the same rejection under 35 U.S.C. § 103(a) with respect to claims 202-204 and 218-220 in an Office Action dated April 4, 2007 (“the April 4th Office

Action"). The Applicants responded to the April 4th Office Action in a Reply dated July 3, 2007 ("the July 3rd Reply") and pointed out to the Examiner that "although *Embrey* was cited for teaching the step of verifying employee information using verification information received from an intermediary, it does not teach [the recitation]." (The July 3rd Reply, p. 17, ll. 11-13.)

As explained by the Applicants, *Embrey*, instead, teaches a "trusted intermediary financial institution" that verifies whether an amount requested for payment to a payee matches an amount requested by a payor. (*Embrey*, col. 3 ll. 47-55.) The purpose of such verification is to "minimize the opportunity for fraudulent manipulation or reconstruction of a negotiable instrument with an altered payment amount or altered check number." (*Embrey*, col. 4 ll. 49-52.) As described in *Embrey*, "the trusted intermediary financial institution [] compare[s] a negotiable instrument with the payment verification information in order to verify the payment amount." (*Embrey*, col. 9 ll. 17-20.)

As set forth above, *Embrey* fails to disclose "a method for processing payments over a network for a plurality of intermediaries, comprising . . . verifying the employee information using verification information received from an intermediary" as alleged by the Examiner, and therefore, fails to disclose the recitations contained in amended independent claim 201 and substantially recited in amended independent claim 217. Accordingly, *Kahn et al* and *Embrey*, taken alone or in combination, fail to teach each element of claims 201 and 217.

Dependent claims 203, 204, 219, and 220 necessarily include the recitations of their respective independent claims, and, therefore, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a) with respect to these claims. Applicants therefore respectfully request that the Examiner withdraw the 35 U.S.C. § 10(a) rejection with respect to claims 203, 204, 219, and 220, as amended.

3. *Kahn et al.* in view of *Fulton et al.*

As stated above, *Kahn et al.* fails to disclose “a method for processing payments over a network for a plurality of intermediaries, comprising . . . verifying the employee information using verification information received from an intermediary” as recited in amended independent claim 201. *Fulton et al.*, which was cited for its alleged disclosure of receiving an error message from a financial clearinghouse if a debit is not successful, fails to remedy the deficiency of *Kahn et al.*

Dependent claim 267 necessarily include the recitations of its independent claim, and, therefore, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a) with respect to claim 267. Applicants therefore respectfully request that the Examiner withdraw the 35 U.S.C. § 10(a) rejection with respect to claim 267, as amended.

Amended claims 202-204, 208, 210, 211, 213, 219-220, 224, 226, 227, 229 and 267 recite elements that are neither taught nor suggested by the cited references. Even if the Examiner is able to identify a reason why a skilled artisan would combine the cited references (which Applicants do not concede), the cited references in combination still

would not disclose or suggest the claimed invention. Accordingly, Applicants request the withdrawal of the section 103 rejections.

IV. Claim Rejection on the Ground of Nonstatutory Double Patenting

The Examiner rejected claims 201-234 under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1-48 of the '669 Patent and over claims 1-70 of the '107 Patent. Applicants note the Examiner's rejections and respectfully request that that these rejections be held in abeyance until such time as the Examiner indicates allowable subject matter.

V. Conclusion

The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statements are identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.


**RESPONSE UNDER 37 C.F.R. § 1.114
EXPEDITED PROCEDURE REQUESTED
EXAMINING GROUP 3694
PATENT
Attorney Docket No. 06556.0039**

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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Dated: January 30, 2008

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